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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,168	11/07/2001	Sandra S. Webb	BS00-340	4958

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EXAMINER

BETIT, JACOB F

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/986,168	Applicant(s) WEBB ET AL.	
	Examiner Jacob F. Betit	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 20, 21, 24, 25 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 20, 21, 24, 25 and 41-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. In response to communications filed on 17 March 2006, claims 1, 20, 24, 25, and 41-43 have been amended, claims 14-19, 22-23, 26-40, and 44-45 are cancelled per the applicant's request. Claims 1-13, 20-21, 24-25, and 41-43 are presently pending in the application.

Claim Objections

2. Claim 1 objected to because of the following informalities:

Claim 1 recites the limitation "a first data values", in line 12; and the limitation "a second data values" in line 15. The "a" does not agree in number with the noun "values" in both of these limitations.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13, 20-21, 24-25, and 41-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the first data value" in line 12. There is insufficient antecedent basis for this limitation in the claim.

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Claim 1 recites the limitation “upon an attempt of the user to make a purchase via the online purchasing system utilizing the data stored in the second database to authorize and complete the purchase”. It is not clear from this limitation what is considered an “attempt” and to what extent a user must attempt to make a purchase before the data stored in the second database is used.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

The step “upon an attempt of the user to make a purchase via the online purchasing system, utilizing the data stored in the second database to authorize and complete the purchase” does not seem to flow with the rest of the claim. Steps are needed to show why data stored in the second database is needed to complete an online purchase. It is not clear what this data is and how it is used given this limitation.

Claims 2-13 are rejected for being dependent on rejected independent claim 1.

Claim 20 recites the limitation “the first set of data values” in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation “when user input confirms that the indication of being connected is displayed, then via the applet”, in line 37-38. It is not clear from the claim what even the conditional is supposed to cause.

Claim 20 recites the limitation “upon an attempt of the user to make a purchase via the online purchasing system”, in line 39. It is not clear from this limitation what is considered an

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“attempt” and to what extent a user must attempt to make a purchase before the data stored in the second database is used.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

The step “upon an attempt of the user to make a purchase via the online purchasing system, the online purchasing system utilizes the data stored in the second database to authorize and complete the purchase” does not seem to flow with the rest of the claim. Steps are needed to show why data stored in the second database is needed to complete an online purchase. It is not clear what this data is and how it is used given this limitation.

Claims 21, 24-25 are rejected for being dependent on rejected independent claim 20.

Claim 41 recites the limitation “via a second set of input fields of the graphical user interface”, in lines 10-11. This renders the claim indefinite because although there is a “first input field” and a “first set of data fields”, the set of input fields claimed in lines 10-11 are the first set claimed. It is therefore unclear why they are called a “second set of input fields”.

Claim 41 recites the limitation “upon an attempt of the user to make a purchase via the online purchasing system”, in line 35. It is not clear from this limitation what is considered an “attempt” and to what extent a user must attempt to make a purchase before the data stored in the second database is used.

Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

The step “upon an attempt of the user to make a purchase via the online purchasing system, utilize the data stored in the second database to authorize and complete the purchase” does not seem to flow with the rest of the claim. Steps are needed to show why data stored in the second database is needed to complete an online purchase. It is not clear what this data is and how it is used given this limitation.

Claims 42-43 are rejected for depending from rejected independent claim 41.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-13, 20-21, 24-25, and 41-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. That claims do not recite a practical application by producing a physical transformation or producing a useful, concrete, and tangible result. To perform a physical transformation, the claimed invention must transform an article of physical object into a different state or thing. Transformation of data is not a physical transformation. A useful, concrete, and tangible result must be either specifically recited in the claim or flow inherently therefrom. To be useful the claimed invention must establish a specific, substantial, and credible utility. To be concrete the claimed invention must be able to produce the same results given the same initial starting conditions. To be tangible the claimed invention

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must produce a practical application or real world result. In this case the claims fail to perform a physical transformation because the claims are directed to operating on data. The claims do not require a useful, concrete, and tangible result to be realized because the useful, concrete and tangible result only occurs when a user “attempts” to make a purchase, and the purchase is authorized and completed. Just because the user attempts to perform an action does not mean the action occurs.

Response to Arguments

7. Applicant's arguments with respect to claims 1-13, 20-21, 24-25, and 41-43 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob F. Betit whose telephone number is (571) 272-4075. The examiner can normally be reached on Monday through Friday 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

jfb
17 Jul 2006


SAM RIMELL
PRIMARY EXAMINER